

REMARKS

Applicants respectfully traverse and request reconsideration.

The non-final Office Action states that the subject matter previously presented in claims 1-5 and 7-8 drawn to an apparatus and classified in class 345, subclass 614 ("Invention I") is a distinct invention from the subject matter previously presented in claims 9 and 11-13, drawn to a method and classified in class 358, subclass 518 ("Invention II"). As noted, inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). The Office Action asserts that "the process as claimed can be practiced by another materially different apparatus such as a printer for printing color image [sic]. In addition, the apparatus as claimed can be used to practice another and materially different process such as a process for gamut clipping of a color image." (Page 2, ¶ 3).

While traversing the above restriction, Applicants provisionally elect Invention I in accordance with MPEP § 818.03(b).

Applicants respectfully traverse the above restriction requirement because it facially cuts against the requirement of 37 C.F.R. § 1.142(a), second sentence which indicates that a restriction requirement "will normally be made before any action upon the merits; however, it may be made at any time before final action." According to MPEP § 811, "This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise as soon as the need for a proper requirement develops. Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." "If the search and examination of all the claims in an application can be made without serious burden, the examiner

must examine them on the merits, even though they include claims to independent or distinct inventions.” MPEP § 803 (Emphasis added.)

Applicants note that the present restriction requirement comes not only after any action upon the merits, but comes after: (1) a first non-final action, (2) a final action, (3) an advisory action, and (4) a second non-final action after Applicants’ Request for Continued Examination. Consequently, the present requirement cannot be said to be before final action as required by the Patent Rules. For this reason alone, Applicants respectfully request withdrawal of the restriction requirement.

Applicants further note that the only amendments made to the claims since the application was filed address the cancellation of claims 6 and 10 and the incorporation of this subject matter into independent claims 1 and 9, respectfully. Because the cumulative scope of the claims as a whole has not changed since the application filing date and because the Office has already issued two separate non-final office actions, a final action and an advisory action, it can hardly be shown that a serious burden will exist if a restriction is not required. If this were the case, Applicants respectfully question how the Office properly issued the above listed actions. In any event, this position is buttressed by the fact that the Examiner has already had at least two opportunities, corresponding to the issuance of each non-final office action, to conduct prior art searches with respect to the present application. Because the restriction requirement fails the tests articulated in MPEP § 811, the requirement should be withdrawn.

In view of the foregoing, Applicants further submit that principles of equity cut against the affirmation of the present restriction requirement. As implied by MPEP § 803, a serious burden on Applicants may exist if Applicants are untimely issued a restriction requirement when the Office had an earlier opportunity to issue such a requirement. Applicants respectfully submit

that not only does the present restriction requirement cause a significant inconvenience to Applicants, but it also imposes a serious burden on Applicants in that additional fees will likely be required to obtain patent rights in the non-elected claims first presented for examination nearly three years ago on February 12, 2004. For this reason, because the present restriction requirement delays prosecution and those reasons articulated above, the restriction requirement is improper and should be withdrawn.

Applicants further note that the preambles of claims 1-5 and 7-8 have been amended to recite "an apparatus." Notwithstanding the above remarks, Applicants respectfully submit that the Office Action has not met the requirements of MPEP § 806.05(e) which requires the Office "to provide reasonable examples that recite material differences" when applying the two-pronged test articulated above. As to the part one of MPEP § 806.05(e), the Office asserts that the process as claimed can be practiced by another and materially different apparatus such as a printer for printing color images. However, Applicants respectfully submit that the Office is silent as to explaining how a printer for printing color images is materially different than the claimed apparatus which includes a rasterizer operative to generate fragment data to be rendered in response to primitive information and a pixel appearance determination circuit, coupled to the rasterizer, operative to determine a pixel appearance value based on the fragment data by dropping the fragment data having the least effect on pixel appearance, wherein dropping the fragment data further includes assigning the fragment data to be dropped with a no color designation. Because it is believed that there is no reasonable material differences between the claimed apparatus and a printer for printing color images as suggested by the present Office Action, it is respectfully believed that although the claimed process may be practiced by a printer for printing color images, the printer is not materially different than the claimed apparatus.


As to part two of MPEP § 806.05(e), the Office Action asserts that the claimed apparatus can be used to practice another and materially different process such as a process for gamut clipping of a color image. Again, Applicants respectfully submit that this bald conclusion is not supported by the Action. Although the apparatus as claimed may be practiced by a process for gamut clipping, Applicants respectfully submit that a gamut clipping process, without more explanation from the Examiner, is not materially different than the claimed process which includes receiving fragment data for a pixel to be rendered, storing the fragment data, and determining an appearance value for the pixel based on the stored fragment data, wherein at least one of the stored fragment data is dropped when the number of fragment data per pixel exceeds a threshold value, wherein dropping at least one of the stored fragment data further includes providing the dropped fragment data with a no color designation.

Because no part of the two-pronged test articulated in MPEP § 806.05(e) has been satisfied, Applicants respectfully request the withdraw of the restriction requirement.

Applicants respectfully submit that the claims are in condition for allowance and respectfully request that a timely Notice of Allowance be issued in this case. The Examiner is invited to contact the below listed attorney if the Examiner believes that a telephone conference will advance the prosecution of this application.

Respectfully submitted,

Date: 10/2/06

By: 
Christopher J. Reckamp
Registration No. 34,414

Vedder, Price, Kaufman & Kammholz, P.C.
222 North LaSalle Street, Suite 2600
Chicago, Illinois 60601
phone: (312) 609-7599
fax: (312) 609-5005